loops which are each guided over a plurality of guide rolls;

each of the inner and outer belts being guided over the forming roll and thereafter separating from one another in the area of a separation point located immediately following the forming roll; and

at least one of:

at least one suction element positioned inside the inner loop and adjacent the inner belt on a side which is opposite the outer belt; and

a conditioning device positioned adjacent the outer belt so as to clean the outer belt, wherein at least one of the inner and the outer belts is a dewatering wire having zonally variable wire permeability.

REMARKS

Summary of the Amendment

Upon entry of the above amendment, claims 6 and 28 will have been canceled. Additionally, claims 1, 22 and 68 will have been amended. Accordingly, claims 1-5, 7-27 and 29-70 will be pending, with claims 48-67 and 70 being withdrawn from examination by the Examiner on the basis of a restriction requirement, and with examined claims 1, 22 and 68 being in independent form.

Summary of the Official Action

In the instant Office Action, the Examiner indicated that claims 48-67 and 70 were withdrawn from examination because they are directed to a non-elected invention. However, the Examiner did not make the restriction final. The Examiner also rejected claims 1-47 and 68 and 69 over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Present Amendment is proper for entry

Applicants submit that the instant amendment is proper for entry after final rejection. In particular, Applicants note that no question of new matter nor are any new issues raised in entering the instant amendment of claims 1, 22 and 68 because Applicants have amended these claims to recite features which have been considered by the Examiner and because no new search would be required.

Moreover, Applicants submit that the instant amendment places the application in condition for allowance, or at least in better form for appeal.

Accordingly, Applicants request that the Examiner enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

Restriction Requirement

Claims 1-47 and 68-69 were elected with traverse. Moreover, claims 48-67 and 70 were withdrawn by the Examiner as directed to the non-elected invention. However, the Examiner has not made the restriction final.

Accordingly, at this time, Applicants are not canceling the non-elected claims pending allowance of the elected claims.

Traversal of Rejections Under 35 U.S.C. § 102(b)

Over Kamps

Claims 1-12 and 16 were rejected as being anticipated by WO 96/35018 to KAMPS.

The Examiner asserted that KAMPS, and in particular Fig. 4, discloses all of the features of these claims including, among other things, a forming element and two belts which separate from each other. The Examiner also apparently combines the disclosures of Figs. 4 and 5 to reject some claims as anticipated. Reconsideration of the above-noted rejection is respectfully requested.

As a preliminary matter, by this amendment and in order to advance prosecution, Applicants have amended independent claim 1 to substantially recite that the inner and outer belts are guided by the forming roll and thereafter separating from one another in the area of a separation point, a feature which is clearly not taught by KAMPS. Accordingly, in an

effort to advance prosecution, these claims are believed to be allowable at least for this reason.

Specifically, Applicants respectfully submit that this document fails to disclose, or even suggest, inter alia, a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt, the inner and outer belts being guided by the forming roll and thereafter separating from one another in the area of a separation point, and at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, as recited in amended claim 1.

Applicants note that Fig. 4 of KAMPS shows an embodiment which does not use a forming roll. Thus, it is clear that Fig. 4 does not disclose inner and outer belts which are guided by the forming roll and thereafter separating from one another in the area of a separation point.

Applicants also note that Fig. 5 of KAMPS shows an embodiment in which a suction device 30 is located far away from where the belts 12 and 13 separate, i.e., it is not positioned adjacent the area of the separation point. It is also clear that the suction device 30 is not arranged within the forming roll 15.

Applicants note that the Examiner has apparently relied upon the combination of the embodiments shown in Figs. 4 and 5 in this rejection. However, as the Examiner well knows, such a rejection cannot form the basis of an anticipation rejection. The combination

of embodiments, or the combination of teachings which are found in different embodiments, simply cannot properly form the basis for an anticipation rejection. Moreover, to the extent that such a rejection could properly be made in the context of an obviousness rejection, Applicants note that such a case has not been properly established. Nor has the Examiner set forth any proper basis or motivation for combining the teachings of the embodiments.

Applicants note that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn. An anticipation rejection cannot be based upon the combination of teachings of different embodiments in a single document.

Because this document fails to disclose at least the above mentioned features as recited in at least amended independent claim 1, Applicants submit that this document does not disclose all the claimed features recited in at least amended independent claim 1.

Further, the rejection of claim 6 is rendered moot in as much that this claim has been canceled. Moreover, Applicants submit that claims 2-5, 7-12 and 16 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicants submit that no proper reading of KAMPS discloses or even suggests: that at least the outer belt is a dewatering wire having zonally variable wire permeability as recited in

claim 2; that the tissue web is separated from the outer belt in the area of the separation point as recited in claim 3; that the tissue web is retained by the inner wire after being separated from the outer belt as recited in claim 4; that at least one of the inner and outer belts comprises a circulating continuous dewatering belt as recited in claim 5; that each of the inner and outer belts is a circulating continuous dewatering wire having zonally variable wire permeability as recited in claim 7; that the inner belt contacts the forming element and the outer belt is guided with the inner belt around the forming element such that the outer belt does not come into contact with the forming element as recited in claim 8; that the forming element comprises the at least one suction element as recited in claim 9; that the forming element comprises a suction zone as recited in claim 10; that the at least one suction element is positioned adjacent the area of the separation point as recited in claim 11; that the at least one suction element is provided inside a loop of the inner belt as recited in claim 12; and that the at least one suction element is arranged at least essentially over an entire width of one of the inner belt and the tissue web as recited in claim 16.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection and further request that the above noted claims be indicated as allowable.

Over each of Tietz and Odell

Claim 1 was rejected as being anticipated by US patent 6,235,160 to TIETZ et al.

Claim 1 was also rejected as being anticipated by US patent 5,536,372 to ODELL et al.

The Examiner asserted that TIETZ, and in particular the figure, discloses all of the features of this claim including, among other things, a forming element 11, two belts 5 and 12 which separate from each other and a suction device 6. Reconsideration of the abovenoted rejection is respectfully requested.

The Examiner next asserted that ODELL, and in particular the figure, discloses all of the features of this claim including, among other things, a forming element, two belts 10 and 20 which separate from each other and a suction devices 85a and 85b. Reconsideration of the above-noted rejection is respectfully requested.

Applicants respectfully submit that each of these documents fails to disclose, or even suggest, inter alia, a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt, the inner and outer belts being guided by the forming roll and thereafter separating from one another in the area of a separation point, and at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, as recited in amended claim 1.

Applicants note that the figure of TIETZ shows an embodiment in which a suction device 6 is located far away from where the belts 5 and 12 separate, i.e., it is not positioned adjacent the area of the separation point. It is also clear that the suction device 6 is not

arranged within the forming roll 11.

Applicants further note that Fig. 5 of ODELL shows an embodiment in which suction devices 85a and 85b are not located downstream the forming roll 22A and are not located in an area where the belts 10 and 20 separate, i.e., they are not positioned *adjacent the area of the separation point*. It is also clear that neither suction device 85a and 85b is arranged within the forming roll 22A.

Again, Applicants note that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because each of these documents fails to disclose at least the above mentioned features as recited in at least amended independent claim 1, Applicants submit that neither document discloses all the claimed features recited in at least amended independent claim 1.

Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections and further request that the above noted claim be indicated as allowable.

Traversal of Rejections Under 35 U.S.C. § 103(a)

Applicants traverse the Examiner's rejection of claims 13-15 and 17-21 under 35 U.S.C. § 103(a) as being unpatentable over KAMPS in view of WO 94/28242 to ERIKSON. Applicants also traverse the Examiner's rejection of claims 22-47 and 68 under 35

U.S.C. § 103(a) as being unpatentable over KAMPS in view of ERIKSON and further in view of US patent 6,231,723 to KANITZ.

Applicants additionally traverse the Examiner's rejection of claim 69 under 35 U.S.C. § 103(a) as being unpatentable over KAMPS in view of ERIKSON and KANITZ, and further in view of US patent 6,235,160 to TIETZ.

As a preliminary matter, Applicants again submit that the latter rejection of claim 69, which applies TIETZ, is improper because TIETZ is not prior art with respect to Applicants' invention.

As explained in the previously filed Rule 1.111 Amendment, TIETZ cannot be used as a basis for rejection under 35 U.S.C. 103(a), but would qualify, at first blush, for a rejection under 35 U.S.C. 103(c). Under 35 U.S.C. section 103(c), a 35 U.S.C. 102(e) prior art document cannot form the basis of a 35 U.S.C. 103 rejection if that document is assigned to the same owner or assignee as that of the instant application, provided the application was filed after November 29, 1999. Accordingly, as this application was filed in the US on January 26, 2001 (i.e., after 11-29-99) and as both this application and TIETZ were commonly owned, i.e., by Voith Paper Patent GmbH, on January 26, 2001, this rejection is believed improper.

For the record, Applicants have confirmed to Applicants' representative that on January 26, 2001 (i.e., the filing date of the instant application) both the instant invention and

the invention claimed in US patent 6,235,160 to TIETZ, were either owned by the same entity or were subject to an obligation of assignment to the same entity.

However, in the event that the Examiner may wish to reformulate a new rejection which is instead based upon DE 197 56 422 (the published priority document cited in TIETZ), Applicants are attaching hereto a copy of this document for the Examiner's review and consideration, in the event that the Examiner is unable to obtain copies of the same.

With regard to the two former rejections, the Examiner apparently asserted that KAMPS discloses all the claimed features except for a suction device having adjustable vacuum. However, the Examiner asserted that ERIKSON teaches this feature. Accordingly, the Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify the device disclosed in KAMPS in view of ERIKSON.

Next, the Examiner asserted that KAMPS and ERIKSON disclose all the claimed features except for a conditioning device. However, the Examiner asserted that KANITZ teaches this feature. Accordingly, the Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify the device disclosed in KAMPS in view of ERIKSON and KANITZ.

Finally, the Examiner asserted that KAMPS, ERIKSON and KANITZ disclose all the claimed features except for the shoe press nip. However, the Examiner asserted that TIETZ teaches this feature. Accordingly, the Examiner concluded that it would have been obvious

to one of ordinary skill in the art to modify the device disclosed in KAMPS in view of ERIKSON, KANITZ and TIETZ.

Applicants respectfully submit that no proper combination of these documents disclose or suggest, inter alia, a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt, the inner and outer belts being guided by the forming roll and thereafter separating from one another in the area of a separation point, and at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, as recited in amended claim 1, inter alia, a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt, the inner and outer belts being guided by the forming roll and thereafter separating from one another in the area of a separation point, and at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, wherein the inner and outer belts separate from each other immediately following the forming roll, as recited in amended claim 22, and inter alia, each of the inner and outer belts being guided over the forming roll and thereafter separating from one another in the area of a separation point located immediately following the forming roll and/or that at least one of the inner and the outer belts is a dewatering wire having zonally variable wire permeability, as recited in amended claim 68.

As discussed above, Fig. 4 of KAMPS shows an embodiment which does not use a

forming roll. Thus, it is clear that Fig. 4 does not disclose inner and outer belts which are guided by the forming roll and thereafter separating from one another in the area of a separation point. Additionally, Fig. 5 of KAMPS shows an embodiment in which a suction device 30 is located far away from where the belts 12 and 13 separate, i.e., it is not positioned adjacent the area of the separation point. It is also clear that the suction device 30 is not arranged within the forming roll 15. However, the Examiner has not explained why it would have been obvious to combine the teachings of these embodiments in order to reconstruct Applicants' invention. Thus, it is submitted that, at the very least, the Examiner has failed to satisfy the initial burden of establishing a case for obviousness.

Additionally, it is clear from Fig. 1 that ERIKSON teaches to separate the belts far away from the forming roll 1, i.e., after roll 6. It is also apparent that ERIKSON teaches to locate the suction device 23 at a location which is far away from the forming roll 1. Accordingly, it is clear that this document does not disclose or suggest the at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, wherein the inner and outer belts separate from each other immediately following the forming roll.

Next, KANITZ similarly teaches to separate the belts far away from the forming roll 24, i.e., after pickup box 54. Accordingly, it is clear that this document does not disclose or suggest the at least one suction element being *positioned at least one of within the forming*

roll and adjacent the area of the separation point, wherein the inner and outer belts separate from each other immediately following the forming roll.

Furthermore, as discussed above, TIETZ similarly discloses to locate the suction device 6 at a location far away from where the belts separate. Accordingly, it is clear that this document does not disclose or suggest the at least one suction element being positioned at least one of within the forming roll and adjacent the area of the separation point, wherein the inner and outer belts separate from each other immediately following the forming roll.

Finally, contrary to the Examiner's assertions in the Office action, KAMPS does not disclose or suggest that at least one of the inner and the outer belts is a dewatering wire having zonally variable wire permeability as recited in claim 68. Nor is this feature disclosed or suggested by any of ERIKSON, KANITZ and TIETZ.

Thus, even if these documents were properly combined, which Applicants submit they cannot be, they would nevertheless lack features which are recited in at least amended independent claims 1, 22 and 68. Moreover, each of these documents fails to disclose or suggest the requisite motivation or rationale for combining these documents in the manner asserted by the Examiner. Finally, Applicants submit that ERIKSON, KANITZ and TIETZ fail to cure the deficiencies in KAMPS, and vice versa.

Accordingly, Applicants submit that no proper combination of ERIKSON, KANITZ, TIETZ and KAMPS discloses or suggests the combination of features recited in at least

independent claims 1, 22 and 68, much less, claims 13-15, 17-21, 23-27 and 29-47 and 69 which depend from claims 1, 22 and 68 and further recite: that the at least one suction element comprises a vacuum suction element and wherein the vacuum present inside the suction element is adjustable as recited in claim 13; that the at least one suction element is positioned in front of the separation point, in a web travel direction as recited in claim 14; that the at least one suction element causes the inner belt to separate from the outer belt as recited in claim 15; that the former further comprises at least one blowing element positioned adjacent the outer belt on a side which is opposite the inner belt as recited in claim 17; that the at least one blowing element is located in the area of the separation point as recited in claim 18; that the at least one blowing element is located in the area of the separation point and inside a loop of the outer belt as recited in claim 19; that the at least one blowing element is arranged at least essentially over an entire width of one of the outer belt and the tissue web as recited in claim 20; that the forming element comprises a suction zone having adjustable vacuum as recited in claim 21; that at least one of the inner belt and the outer belt is a dewatering wire having zonally variable wire permeability as recited in claim 23; that the former further comprises at least one suction element positioned adjacent the inner belt on a side which is opposite the outer belt as recited in claim 24; that the tissue web is separated from the outer belt in the area of the separation point as recited in claim 25; that the tissue web is retained by the inner wire after being separated from the outer belt as recited in claim

26; that at least one of the inner and outer belts comprises a circulating continuous dewatering belt as recited in claim 27; that each of the inner and outer belts is a circulating continuous dewatering wire having zonally variable wire permeability as recited in claim 29; that the inner belt contacts the forming element and the outer belt is guided with the inner belt around the forming element such that the outer belt does not come into contact with the forming element as recited in claim 30; that the forming element comprises the at least one suction element as recited in claim 31; that the forming element comprises a suction zone as recited in claim 32; that the former further comprises at least one suction element positioned adjacent the area of the separation point as recited in claim 33; that the at least one suction element is provided inside a loop of the inner belt as recited in claim 34; that the at least one suction element comprises a vacuum suction element and wherein the vacuum present inside the suction element is adjustable as recited in claim 35; that the at least one suction element is positioned in front of the separation point, in a web travel direction as recited in claim 36; that the at least one suction element causes the inner belt to separate from the outer belt as recited in claim 37; that the at least one suction element is arranged at least essentially over an entire width of one of the inner belt and the tissue web as recited in claim 38; that the former further comprises at least one blowing element positioned adjacent the outer belt on a side which is opposite the inner belt as recited in claim 39; that the at least one blowing element is located in the area of the separation point as recited in claim 40; that the at least

one blowing element is located in the area of the separation point and inside a loop of the outer belt as recited in claim 41; that the at least one blowing element is arranged at least essentially over an entire width of one of the outer belt and the tissue web as recited in claim 42; that the forming element comprises a suction zone having adjustable vacuum as recited in claim 43; that the conditioning device comprises a wire cleaning device as recited in claim 44; that the conditioning device is arranged at least essentially over an entire width of one of the outer belt and the tissue web as recited in claim 45; that the inner belt is a felt belt as recited in claim 46; that the former is a crescent former as recited in claim 47; and that the former further comprises a press nip through which the tissue web and the inner belt is guided, the press nip being formed between a cylinder and shoe press roll, wherein the tissue web is removed from the inner belt after passing through the press nip as recited in claim 69.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejections of the above-noted claims under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

Traversal of the Examiner's comments

Regarding the Examiner's suggestion that the suction device 30 shown in Fig. 5 of KAMPS is positioned adjacent the forming roll, Applicants note that this position is entirely contradicted by Fig. 5 of KAMPS. As is clearly shown, suction device 30 is located well

after a downstream guide roll, and well downstream of where belts 12 and 13 separate from each other.

Regarding the Examiner's assertion that Applicants have not specified or defined the term "adjacent", Applicants note that Applicants' Fig. 2 clearly provides one example of such a relative positioning. As is clearly shown there, the suction device 36 is positioned immediately following the forming roll 18 and arranged opposite belt 14. The Examiner has simply failed to fully consider that all of the claims recite that the inner and outer belts separate from each other *immediately following the forming roll*.

Also, it is noted that the Examiner did not address Applicants' arguments regarding applicability of 35 U.S.C. 103(c)/103(a), which was made in the Rule 1.111 Amendment.

Additionally, regarding the Examiner's assertion that page 9, line 15 described a suction device 30 "which is opposite the outlet belt", Applicants note that this language describes the embodiment shown Fig. 4, and not Fig. 5 which is the apparent disclosure upon which the rejections are based. Accordingly, to the extent that the Examiner relies upon the combination of the teachings shown in Figs. 4 and 5, such could not properly form the basis of an anticipation rejection because Figs. 4 and 5 are directed to different embodiments. Moreover, to the extent that the Examiner relies upon the combination of the teachings shown in Figs. 4 and 5 in support of an obviousness rejection, Applicants submit that the Examiner has failed to either indicate such or to meet the initial burden of establishing such.

The Examiner has simply failed to set forth or explain any basis or motivation for combining these embodiments.

Finally, Applicants direct the Examiner's attention to the guidelines identified in M.P.E.P section 2141 which state that "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do

so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Additionally, it has been held that "[a] statement that modifications of the prior art to meet the claimed invention would have been "` well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicants' invention, as recited in each of claims 1-5, 7-27, 29-47, 68 and 69. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art,

should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Respectfully submitted, Thomas THORÖE SCHERB et al.

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Attachment: Appendix

APPENDIX

Changes to claims 1, 22 and 68 as follows:

1. (Twice Amended) A former for producing a tissue web, comprising:

a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt;

the inner and outer belts converging to form a stock inlet nip;

the inner and outer belts being guided [over] by the forming [element] roll and thereafter separating from one another in the area of a separation point;

at least one suction element positioned adjacent the inner belt on a side which is opposite the outer belt; and

the at least one suction element being positioned at least one of:

within the forming [element] roll; and

adjacent the area of the separation point,

wherein the inner and outer belts separate from each other immediately following the forming [element] <u>roll</u>.

22. (Twice Amended) A former for producing a tissue web, comprising:

a forming element comprising a forming roll, an inner dewatering belt, and an outer dewatering belt;

the inner and outer belts converging to form a stock inlet nip;

the inner and outer belts being guided [over] by the forming [element] roll and thereafter separating from one another in the area of a separation point;

a conditioning device positioned adjacent the outer belt; and

at least one suction element being positioned at least one of:

within the forming [element] roll; and

adjacent the area of the separation point,

wherein the inner and outer belts separate from each other immediately following the forming [element] <u>roll</u>.

68. (Amended) A former for producing a tissue web, comprising:

a forming roll, an inner continuous dewatering belt, and an outer continuous dewatering belt;

the inner and outer belts converging to form a stock inlet nip;

a headbox positioned adjacent the stock inlet nip;

each of the inner and outer belts forming corresponding inner and outer continuous loops which are each guided over a plurality of guide rolls;

each of the inner and outer belts being guided over the forming roll and thereafter

separating from one another in the area of a separation point <u>located immediately following</u> the forming roll; and

at least one of:

at least one suction element positioned inside the inner loop and adjacent the inner belt on a side which is opposite the outer belt; and

a conditioning device positioned adjacent the outer belt so as to clean the outer belt, wherein at least one of the inner and the outer belts is a dewatering wire having zonally variable wire permeability.